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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,991	11/14/2003	Jeremy Bem	0026-0057	7360

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EXAMINER

VEILLARD, JACQUES

ART UNIT PAPER NUMBER

2165

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/706,991

Applicant(s)

BEM ET AL.

Examiner

Jacques Veillard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 25-39 and 42-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24, 40 and 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 11/14/2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is responsive to applicant's communication filed on 7/17/2006.
2. Claims 1-24, 40-41 have been provisionally elected to be prosecuted.
3. Claims 1-24 and 40-41 are pending and presented for examination.

### *Answer to Arguments with Traverse*

1. Applicant's election with traverse of claims 1-24, and 40-41 in the reply filed on July 17, 2006 is acknowledged. The traversal is on the ground(s) that the patent office has made an improper restriction requirement by alleging that the inventions of Groups I and II are unrelated. This is not found persuasive because invention in Group I, drawn to a method and system for ranking documents, wherein documents related to a search query have been identified and scoring based on a ranking model, classified in class 707, subclass 005. Invention in Group II, drawn to a method and system for generating a model by selecting a candidate condition includes one or more features, estimate a weight for the candidate condition and forming a rule from the candidate condition and the weight, classified in class 707, subclass 102. It appears that inventions are unrelated and because the search required for each group is different and not co-extensive for examination purpose, these groups would require different searches in PTO's classification class and subclass. Therefore, the search required for invention in Group I would not required for the invention in Group II and the search required for the invention in Group II would not required for the invention in Group I.

The requirement is still deemed proper and is therefore made FINAL.

2. This application contains claims 25-39, and 42-46 drawn to an invention nonelected with traverse in Paper No. /mail date 07/17/2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim recites the limitation “when the likelihood of the training data when the model includes the rule is greater than when the model the model does not include the rule.” This language is awkward, it is nuclear to the examiner of what the applicant(s) meant by “when the likelihood of the training data when the model includes the rule is greater than when the model the model does not include the rule” in the claim.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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6. Claims 1-15, are re rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, specifically directed toward an abstract idea.

Claim 1 as written, appears to be directed to an abstract idea rather than a practical application of the idea, since no tangible result appears to occur. What is identifying and forming is neither applied in a disclosed practical application nor made available for use in a disclosed practical application so as to constitute a tangible result. Instead, it appears to be just an abstraction because the search query is not intended to providing the search results. Therefore, claim 17 is rejected under 35 U. S. C. 101.

As per claims 2-15, they are at least rejected for their dependencies directly or indirectly, on the rejected claim 1 above.

As per claims 40 and 41, they are rejected in the basis analysis as claim 1 for lack of tangible result, since the step of “generating search results” may also be just formulating the search results and therefore not a tangible result.

7. Claim 16 is re rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, specifically directed toward software, per se.

Claim 16 appears to be directed to a system of software alone, functional descriptive material per se. The system as claimed is made up of 4 means, when turning to the applicant's specification page(s) 8 section [0029] and page(s) 18 section [0061], it is clear that each of means could be software. Therefore, the system is just software, functional descriptive material

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per se. Since the software program constituting the system is not been claimed as embodied in a computer, the claim is not directed to statutory subject matter. Without the above, the functionality of the software cannot be realized since it is not directly accessible by computer. Therefore, claim 16 is rejected under the doctrine of 35 U.S.C. 101 as being non-statutory.

8. Claims 17-24 are re rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 17, it appears applicant(s) is/are not seeking to patent the elements of the system and their interconnections but programmed functionality of the elements of the system. Since that programmed functionality does not appear to be producing a tangible result, which enables any usefulness of having done the ranking to be realized, it appears to be non-statutory. Therefore, the claim is rejected under 35 U. S. C. 101.

As per claims 18-24, they are at least rejected for their dependencies directly or indirectly, on the rejected claim 17 above.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 1, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal et al. (U. S. Pat. No. 6,546,389) in view of Edlund et al. (U. S. Pat. 6,546,388).

As per claims 1 and 16, Agrawal et al. disclose a system and method for mining data suggesting a ranking model for ranking documents, wherein with the ranking model being used at the user computer that predicts a likelihood that a document will be selected by ranking a search results based on the user's individual classification (See Agrawal et al. abstract ). As to the limitation of training the ranking model using a data set that includes approximately tens of millions of instances, Agrawal et al. provide a synthetic data generator and a training set containing millions of records(See Agrawal et al. col.6, lines 56-63).

Even though Agrawal et al. suggested generating a search and ranking the search results (See Agrawal et al. col.4, lines 38-45), it is noted, however, Agrawal et al. did not specifically disclose identifying documents relating to a search query; scoring the documents based, at least in part, on the ranking model; and forming search results for the search query from the scored documents. On the other hand, Edlund et al. achieved these claimed features by providing a metadata search results ranking system permitting end-user identifying documents relating to a search query, by presenting a number of documents matching the keyword terms to the end-user (See Edlund et al. Abstract and col.3, lines 24-36); scoring the documents based, at least in part, on the ranking model by providing a query association metrics and a relevancy calculator wherein a variety of information associated with the search query must be evaluated to determine the ranking score (See Edlund et al. Fig.1 and Fig.2 and col.11, lines 10-17) and forming search results for the search query from the scored documents (See Edlund et al. col.8, line 31 through col.9, line 15).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention was made to modify the system and method for mining data of Agrawal et al. by incorporating the metadata search results ranking system mechanism taught by Edlund et al. The motivation being to have enhanced the system of Agrawal et al. by allowing it to associate a search results with specific search query string in order to permit improvement in the search ranking efficiently and current search results to be more easily interpreted and filtered by the interactive user (See Edlund et al. col.2, lines49-50, 55-58 and col.21, lines 39-45)

***Allowable Subject Matter***

10. Claims 2, 5, 12, 20, 22, and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Other Prior Art Made Of Record***

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. U.S. patents and U.S. patent application publications will not be supplied with Office actions. Examiners advises the Applicant that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. For the use of the Office's PAIR system, Applicants may refer to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.



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***Points Of Contact***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques Veillard whose telephone number is (571) 272-4086. The examiner can normally be reached on Mon. to Fri. from 9 AM to 4:30 PM, alt. Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272- 4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

  
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August 24, 2006